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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,172	10/21/2003	Rajendra Mehta	STD 1204 PA/41213.558/PD	3945
7590 09/28/2004			EXAMINER	
DINSMORE & SHOHL LLP Suite 500 One Dayton Centre Dayton, OH 45402-2023			FAISON, VERONICA F	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,172	Applicant(s) MEHTA, RAJENDRA	
	Examiner Veronica F. Faison	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4-15,17-23 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 3,16 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1-23-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preamble

The preamble limitation "said water-based ink is formulated to enable said water-based ink to be used in flexographic printing processes" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

Claim Objections

Claim 12 is objected to because of the following informalities: Claim 12, line 2, the word "pyrrolidone" appears to be misspelled and should be replaced with – pyrrolidone--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-7 and 28 contains the trademark/trade name "Dynacolor pigment", "Mearlin Dynacolor BY-B", "Mearlin Dynacolor GY", and "Mearlin Dynacolor Hi-Lite Super Gold". Where a trademark or trade name is used in a claim as a limitation to

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identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe optically variable pigment and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by over Inoue et al (US Patent 6,730,154)

Inoue et al teach a polychromic ink composition depending on viewing angle comprises 0.5 to 40 percent by weight of cholesterol liquid crystal polymer particles, 0.1 to 30 percent by weight of binder resin, 0.5 to 20 percent by weight of pigments with a

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deep-colored coloring matter and water (abstract). The binders present in the composition may include carboxymethyl cellulose, polyvinyl alcohols and polyvinyl pyrrolidones in the amount of 1 to 3 percent by weight (col. 9 lines 1-36). The reference teaches that water is the main solvent present in the composition (col. 9 lines 53-55). The composition as taught by Inoue et al appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-9, 17-23, 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bleikolm et al (US Patent 6,521,036).

Bleikolm et al teach an optically variable pigment having a color shift between two distinct colors of any of the known designs (abstract and col. 1 lines 9-14). The reference further teaches that the optically variable pigment can be incorporated in water based coating compositions particularly printing inks (col. 5 lines 5-8). The printing inks containing the optically variable pigments may be present may be applied to any kind of substrate, printing ink are applied to security documents for anti counterfeiting purposes. The color shift of the pigment is not reproducible by photocopying machines, indicia printed with optically variable pigment with a strong security element which is useful for authentication of banknotes and cheques (col. 7

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lines 32-45). The reference further teaches printing inks having the incorporated optically variable pigment can be applied to a substrate by any of the known printing techniques such as flexo (col. 7 lines 63-67). Bleikolm et al fails to specifically exemplify the use of optically variable pigment in an ink composition as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the optically variable pigment in an ink composition as claimed by applicant as Bleikolm et al also discloses the use of optically variable pigment in an ink composition but shows no example incorporating them.

Claims 1-2, 4-7, 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al (US Patent 5,171,363).

Phillips et al teach articles and methods for forming optically variable thin film flakes. The flakes are disposed in ink and paint vehicles to provide optically variable inks (abstract and col. 1 lines 14-18). The dichroic composition may be used in security inks and decorative plastics (col. 3 lines 43-46). The optically variable ink can be utilized in various printing processes such as flexographic printing (col. 15 lines 39+). The reference remains silent to the solvent used in the ink composition. The reference teaches that the optically variable pigment may be present in the amount of 10 to 50 percent by weight depending on the type of composition (col. 17 lines 47-55). Phillips et al fails to specifically exemplify the use water in an ink composition as claimed by applicant. However it is the position of the Examiner that water-soluble components are used therefore water is present in the ink composition absence evidence to the contrary.

Allowable Subject Matter

Claims 3, 16, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The reference alone or in combination fail to teach the specific limitations set forth in the above claims.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the Examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Veronica F. Faison